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In the Supreme Court of the United States

OCTOBER TERM, 1933.

KEYSTONE DRILLER COMPANY, *Petitioner,* vs. GENERAL EXCAVATOR COMPANY, *Respondent.*	No. 34.
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KEYSTONE DRILLER COMPANY, *Petitioner,* vs. THE OSGOOD COMPANY, *Respondent.*	No. 37.

BRIEF IN OPPOSITION TO MOTION TO RECALL AND CORRECT MANDATES.

Status: The Motion and brief to recall and correct the mandates was received by registered mail February 23, 1934. Thereafter on February 27, 1934, a notice of hear-

ing on the Motion was received setting March 5th as the date of submitting the Motion to the Honorable Court.

The decision to which this Motion relates was handed down on December 4, 1933,* and which affirmed the decision of the Circuit Court of Appeals for the Sixth Circuit on a single question presented to this Court by the Petitioner from a decision dismissing the Bills of Complaint *without prejudice* on the ground that the Petitioner, Keystone Driller Company, came into Court with unclean hands.** The question presented to this Court was whether or not all of the patents in suit should come within the decree of the Sixth Circuit Court of Appeals where only one of the patents was sullied in the first instance.

On January 5, 1934, this Court issued mandates to the Honorable Judges of the District Court for the Northern District of Ohio in conformity with the decision of this Court. These mandates were endorsed by His Honor Judge Hahn and filed by the Clerk of the District Court of the Northern District of Ohio on January 9, 1934. The present motion to recall and correct the mandates was not filed until on or about February 23, 1934. In the meantime the Keystone Driller Company has on January 16, 1934, filed its bills in equity in the Northern District of Ohio in accordance with the mandate of this Court and the ruling of the Court of Appeals which this Court affirmed. Service was had on the Osgood and General Companies on January 19, 1934.

The motion requests this Court to change its decision affirming the Court of Appeals for the Sixth Circuit, to a decision enlarging the decision of the Appellate Court, and to give additional relief by dismissing the Bills *"with prejudice."*

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* *Keystone v. General Excavator Company*, 78 L. Ed. 202 (advance sheets).

** C. C. A. Decision at 62 Fed. (2) 48, and 64 Fed. (2) 39.

The Motion to Recall and Correct the Mandates should be denied for the following reasons:

1. That although labelled a Motion to Recall and Correct the Mandates the name is a misnomer and in effect is asking this Court for a rehearing of its decision of December 4, and is for the sole purpose of reconsideration of this decision and as such comes without the rule.

2. If the Motion can be correctly termed a Motion to Correct the Mandate the motion should be denied on the ground that the Respondents urged this Court to affirm the Circuit Court of Appeals.

3. That no mistake was made by the Court or Clerk which should be corrected.

4. Laches of the Respondents (moving party).

5. Parties who do not apply for certiorari can only be heard in support of the decree.

(1) That although labelled a Motion to Recall and Correct the Mandates the name is a misnomer and in effect it is asking this Court for a rehearing of its decision of December 4, and is for the sole purpose of reconsideration of this decision and as such comes without the rule.

If this Court were to comply with the Motion it must, of necessity, do more than merely correct the mandates, and this we believe to be the purpose and function of a petition for rehearing.* The order was clear and plain "Decrees affirmed," and if there was any dissatisfaction to be found the Court's attention should have been called to that fact within the time for rehearing, namely twenty-

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* Rule No. 33 of this Court provides that: "A petition for rehearing may be filed with the clerk * * * within twenty-five days after judgment is entered."

five days after the decision of December 4, 1933. The doctrine as stated in *Gantley v. Ewing*, 3 How. 707, 717, 11 L. Ed. 794, 798, applies here, and where this Court said:

> "as an act directly prohibited, could not be done indirectly."

The Respondents, having slept on their rights, if any they had, cannot now come into Court by a Motion to Correct the Mandate and attempt to do indirectly that which should have been done on or before December 29, 1933.

(2) If the Motion can be correctly termed a Motion to Correct the Mandates the motion should be denied on the ground that the Respondents urged this Court to affirm the Circuit Court of Appeals.

For the first time in the litigation before this Court, in the subject cases, the Respondents have expressed dissatisfaction with the decrees of the Circuit Court of Appeals by their Motion to correct the Mandates. We believe they are now estopped to change their position. In their main brief, page 50, before this Court on the hearing, their position at that time was clearly expressed as follows:

CONCLUSION

> "In view of the foregoing we submit that the decree of the Circuit Court of Appeals *should be affirmed.*
>
> Respectfully submitted,
>
> EDWIN P. CORBETT,
> LLOYD F. WILLIAMS,
> EDWARD L. REED,
> JOHN J. MAHONEY.
>
> WADE H. ELLIS,
> CHALLEN B. ELLIS,
> *Of Counsel.*"

In view of the foregoing statement of the Respondents urging the Court to enter the very order about which they now seek to have changed or corrected it should dispel any doubt in the minds of the Court that a mistake was made.

(3) That no mistake was made by the Court or Clerk which should be corrected.

The Motion to Correct the Mandates is moreover beyond the scope of such procedure. There must have been a mistake to correct as succinctly stated by the Circuit Court of Appeals for the Third Circuit in *Kosak vs. United States,* 54 Fed. (2) 72, where Judge Wooley, speaking for that Court, said at page 72:

> "We find no mistake in the simple entry of 'Judgment reversed' without a direction for a new trial occurring in the mandate in question. Hence *we cannot recall the mandate to correct a mistake which is not there,* nor, had we the power, are we inclined through amendment to make certain by express words what in law the words themselves imply." (Emphasis ours throughout except as otherwise indicated.)

The order of this Court "Decrees affirmed" is even more clear than the case of *Kosak vs. United States.* If it means anything, it means the decrees of the Circuit Court of Appeals which were being considered. It is a commonplace that courts speak through their decrees and if the Respondents had any doubt as to the meaning of the decrees, the question should have been presented to the Circuit Court of Appeals.

(4) Laches of the Respondent (moving party).

The Respondents had the right to apply to this Court for a Writ of Certiorari to that portion of the decision of the Circuit Court of Appeals which they believed to be adverse to them and by their failure to avail themselves of

that right they cannot come into this Court, long after the Court has rendered its decision and the mandate has issued thereon and by a motion to correct the mandate receive the relief they now seek. The failure and laches of the Respondents should not be placed on the shoulders of the Court, or the Clerk of the Court.

(5) Parties who do not apply for certiorari can only be heard in support of the decree.

It is a settled rule also that parties who do not appeal cannot be heard except in support of the decree. The rule is well stated in *The Stephen Morgan v. Good,* 94 U. S. 599, 24 L. Ed. 266, and where Mr. Justice Clifford said at page 599:

> "Parties who do not appeal from a final decree of a circuit court, which is regular in form, cannot be heard in opposition to the decree when the cause is removed here by the opposite party, unless it appears that the proceedings in removing the cause were unauthorized or irregular. They may be heard in support of the decree and in opposition to every assignment of error filed by the appellants. *The Wm. Bagaley,* 5 Wall. 377 (72 U. S. XVIII 583); *Harrison v. Nixon,* 9 Pet. 494; *Canter v. Ins. Co.,* 3 Pet. 318."

This rule has been applied to writs of certiorari as well as appeals where this Court in *Hubbard v. Tod,* 171 U. S. 474, 494, 43 L. Ed. 246, 253, the Court said:

> "And as respondents did not apply for certiorari, we shall confine our consideration of the case to the examination of errors assigned by petitioner."

The Respondents' position heretofore has not been inconsistent with this rule. They did not apply for certiorari. Their brief shows a desire to have the Appellate Court affirmed. This petitioner did not assign as error the decrees of the Appellate Court dismissing the bills with-

out prejudice. The belated motion to correct the mandates should not now enlarge the relief with which the Respondents were content when the cause was before this Court and the Circuit Court of Appeals.

Discretion of the Court: In contempt cases where one of the parties has been at fault the punishment to be imposed is within the sound discretion of the Court and will not be disturbed unless grossly excessive. *Conley v. United States*, 59 Fed. (2) 929, 936 (C. C. A. 8). In cases such as this where the bills of complaint have been dismissed without prejudice, the punishment or penalty imposed is the dismissal with the resulting loss where the patents are infringed. We do not believe that the decision of the Court of Appeals shows any abuse of discretion.

The facts surrounding the acts of the petitioner which resulted in the bills being dismissed without prejudice in the present cases have been presented to His Honor Judge Jones since that issue has become of prime importance. *Byers vs. Keystone*, 4 Fed. Sup. 159 (D. C. Ohio).

The statement made by this Court in the decision herein (78 L. Ed. 202, advance sheets) at page 205 where it is said:

> "Had the corruption of Clutter been disclosed at the trial of the *Byers* case, the Court would have been warranted in holding it sufficient to require dismissal of the cause of action there alleged for the infringement of the Downie patent."

The alleged suppression was disclosed fully for the first time in a rehearing before the Trial Court in the *Byers* case. The accusing witness Clutter was for the first time brought to court. After hearing fully the accused and the accusing witnesses, Judge Jones found that there had been no suppression and dismissed the proceedings. His opinion appears at 4 Fed. Sup. 160. On this subject he said (pp. 160 and 161):

"It is idle to suppose that Clutter did not know what he had signed and agreed to with respect to the Joplin use. If he did not, *he then was under no obligation of silence as far as he was concerned, and therefore under no suppressive influence.*"

(p. 162)

"Upon that phase of the case, however, I find that Downie endeavored to secure for his own protection whatever rights Clutter may have had to the improvement, for the purpose of avoiding any trouble in sustaining his patent, together with the denial of prior use by Clutter. I find that Downie did not successfully accomplish this purpose, that such arrangement as was entered into with Clutter was breached prior to trial of this case, *and that Clutter was under no suppressive influence or obligation at that time respecting his alleged invention or prior use.* I find there was no suppression of evidence materially affecting the defendant's rights." (Emphasis ours.)

He further held that the Joplin prior use about which all this controversy has raged was an abandoned experiment, did not anticipate and was not proved.

Cases relied upon by the Respondents: In the case of *Lake St. El. R. Co. vs. Ziegler,* 99 Fed. 114 on page 5 of Respondents' brief is not in point for as stated *both* parties appealed while here the Respondents did not apply to this Court for certiorari. The cases citing want of equity on pages 6 and 7 do not meet the situation here for each case must be determined on its own facts and is within the discretion of the chancellor as to the penalty to be imposed. (*Francis vs. David A. Manville,* 296 Fed. 349, 352 (C. C. A. 2).

The Respondents on page 8 of their brief now state that the mistake to which their motion relates originated in the decree of the Circuit Court of Appeals and still they failed to request that Court to reconsider its decision and,

still more, nothing was done in this Court which would indicate such a mistake had been made until February 23 when this motion was filed.

CONCLUSION.

It is respectfully submitted that the motion to recall and correct the mandates be denied.

Respectfully,

F. O. RICHEY,
WILLIAM H. BOYD,
H. F. MCNENNY,
Of Counsel for Petitioner.